

**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

Appl. No. : 10/585,368
Applicant(s): Mathias Wendt, et al.
Filed: July 5, 2006
TC/A.U.: 2800/2836
Examiner: Adi Amrany
Atty. Docket: DE 040014
Confirmation No.: 2478
Title: DECENTRALIZED POWER GENERATION
SYSTEM

Pre-Appeal Request for Review

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In conjunction with the Notice of Appeal filed concurrently, please reconsider the application in light of the following remarks.

This paper includes **(each beginning on a separate sheet)**:

1. Remarks/Discussion of Issues;

I. REMARKS / DISCUSSION OF ISSUES

Applicants file herewith a Notice of Appeal to the Board of Patent Appeals and Interferences. In the meantime, Applicants provide a Pre-Appeal Brief Request for Review. Applicants have chosen to address certain issues presently. Their silence on aspects of the Office Action not specifically addressed is not acquiescence to the positions set forth in the Office Action.

a. Claim of inherency remains unaddressed

The Office Action asserts that it is “inherent that the voltage supplied to the Jepsen converters is always above ‘a threshold voltage’.” The Office Action then relegates the threshold voltage to zero (0) volts. Applicants traversed the claim of inherency as improper on pp. 9-10 of the Response under Rule 111. The final Office Action fails to address Applicants’ traversal, and the rejection maintains the asserted threshold voltage. The claim of inherency thus remains improper.

b. Filed application includes support for DC/DC converters’ not buffering energy

In the response to Applicants’ arguments, the Office Action asserts that insufficient support is provided in the specification for DC/DC converters that “do not buffer energy.” Notably, claim 1, for example features *DC/DC converters none of which are configured to buffer energy*. The final Office Action also rejects claim 1-19 under 35 U.S.C. § 112, ¶1 for allegedly failing to comply with the enablement requirement. Applicants respectfully demur.

Enablement is a question of law. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988) held that the test “is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” If an application is without any description as to how to implement a claimed feature, it has been held that the claim necessarily requires undue experimentation in order for one of ordinary skill in the art to make or use them.

In describing certain advantages, the application recites:

“...it is an advantage of the invention that high direct currents provided by the power generating units do not have to be transferred a long way to a central power receiving unit, since the high direct currents can be converted immediately by the DC/DC converter associated to the respective power generating unit. Further, the invention enables a particularly simple modular and extendible mounting of the system.

...it is an advantage of the invention that those components of the system which are subject to adverse environmental conditions, for instance on a roof, can be constructed without electrolyte capacitors and thus in a way which ensures a long life and a high reliability. That is, the DC/DC converters can be arranged close to the power generating units, which may be subject to adverse environmental conditions, while the more sensitive power receiving component can be arranged at a sheltered location. Expensive components in the DC/DC converters can be avoided...

The presented PV power plant has further the advantage that the DC/DC converters 31, 32 required basically no buffering of energy. Therefore, no electrolyte capacitors, which reduce the durability of a device, are required in the DC/DC converters 31, 32.” (See page 5, lines 15-25, and page 11, lines 1-4 of the filed application)

So, in at least the noted portions of the filed application, provides a description of the immediate conversion of high DC currents, and the DC/DC converters, which are disposed close to power generating units in possibly harsh environmental conditions, do not include electrolytic capacitors. Moreover, no buffering of energy is not needed. Applicants respectfully submit that based at least on the description in the noted portions of the filed application, the enablement requirement is met.

c. *Prima facie* case of obviousness has not been established

While Applicants in no way concede that all features of claims 1-19 are disclosed in the applied art, Applicants respectfully submit that a *prima facie* case of obviousness has not been established because the requisite motivation to combine references is not provided in the Office Action.

If there is no suggestion to combine the teachings of the applied art, other than the use of Applicants' invention as a template for its own reconstruction, a rejection for obviousness is improper. *Ex parte Crawford, et al.* Appeal 20062429, May 30, 2007. In

furtherance to the need for the suggestion to combine the teachings of the applied art, it is established that rejections on obviousness grounds cannot be sustained by mere conclusory statements: instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l v. Teleflex*, 127 S. Ct. at 1741.

In combining *Jepsen, et al.* with *Vinciarelli, et al.*, the Office Action asserts that “At the time of the invention by applicants, it would have been obvious to replace the DC/AC and AC/DC converters in Jepsen with the DC/DC disclosed in Vinciarelli in order to reduce the number of parts in the converter.”

First of all, there is no basis given as to how the supplanting of the DC/AC converter would reduce the number of parts. Moreover, there is no basis provided that such a move would accord the function desired, and that no energy buffering would be realized with such a change in parts according to the teachings of *Jepsen, et al.* or *Vinciarelli, et al.* Thus, Applicants respectfully submit that no clear support has been provided for the proposed transplanting the DC/DC devices of *Vinciarelli, et al.* for the AC/DC devices of *Jepsen, et al.* Accordingly, Applicants respectfully submit the requisite articulated reasoning with some rational underpinning to support the legal conclusion of obvious has not been provided. Rather, a generic benefit is asserted, and lacks support as to why it is useful and whether it will even effect the same result.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

/William S. Francos/
by: William S. Francos (Reg. No. 38,456)
Date: June 3, 2009

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